

REMARKS

Claims 1 – 53 are pending in the application. Claims 5-28, 31-33, 37-49 and 53 have been withdrawn from further consideration. Claims 1-4, 29-30, 34-35, and 50-52 have been amended to place the claim language in proper U.S. format. Applicants retain the right to pursue the subject matter of any of the withdrawn or amended subject matter claims at the appropriate later time or times.

The amendments do not include any new subject matter within the meaning of 35 U.S.C. §132. Therefore, entry of the amendments is respectfully requested.

Claim Rejection - 35 U.S.C. §101

The Examiner has rejected claims 1-4, 29, 30, 34-36 and 50-52 as being directed to nonstatutory subject matter for reciting a “use”.

Applicants respectfully submit that the recited claims, with the exception of claim 36, which was not directed to a use, have been amended to be directed to a method and, as such, are now directed to patentable subject matter under 35 U.S.C. §101.

Accordingly, the bases for this rejection have been removed, and Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Claim Rejection – 35 U.S.C. §112, second paragraph

The Examiner has rejected claims 1-4, 29, 30, 34-36 and 50-52 as being indefinite for failing to particularly point out and distinctly claim the claimed subject matter. The Examiner cited the recitation of a “use” in these claims, without any associated active steps, as the source of the indefiniteness.

Applicants respectfully submit that the recited claims, with the exception of claim 36, which was not directed to a use, have been amended to be directed to a method and, as such, particularly point out and distinctly claim the instantly claimed subject matter as required under 35 U.S.C. §112, second paragraph.

Accordingly, the bases for this rejection have been removed, and Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Claim Rejection – 35 U.S.C. §102(e)

The Examiner has rejected claims 1-4, 29, 30, 34-36 and 50-52 as being anticipated by Schlegel et al. in U.S. Published Patent Application No. 20030108963.

The Examiner states that the instant claims are drawn to a method of diagnosing prostate cancer comprising detecting a level of annexin A3 as compared to a control. The Examiner continues by stating that Schlegel et al. teach methods of detecting and diagnosing human prostate cancer, while disclosing diagnostic markers, including annexin A3 as particularly useful in both screening for the presence of prostate cancer, as well as, for metastatic potential of prostate cancer. The Examiner also states that Schlegel et al. discloses the use of antibodies which specifically bind to the marker proteins for diagnostic purposes and a kit.

Applicants traverse this rejection, and respectfully point out that Schlegel et al. only disclose a differential expression of annexin 3 RNA in prostate tissue while the instantly claimed subject matter is directed to annexin A3 protein as a diagnostic marker for prostate cancer. Since Schlegel et al. only show differential expression of annexin A3 RNA, the document fails to teach how annexin A3 protein should be used as a diagnostic marker.

Accordingly, the basis for this rejection has been removed, and Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Conclusion.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejection and to allow all of the claims pending in this application.

Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.


In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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